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10/625,823	07/23/2003	Scott Goldthwaite	WS-102	7792
27769	7590	07/29/2009		
AKC PATENTS 215 GROVE ST. NEWTON, MA 02466			EXAMINER HANNON, CHRISTIAN A	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/625,823
Filing Date: July 23, 2003
Appellant(s): GOLDTHWAITE ET AL.

Aliki K. Collins
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/14/2009 appealing from the Office action mailed 11/14/2008.

(1) Real Party in Interest

The real party in interest is Way Systems Inc., a Delaware Corporation, having a place of business at 200 Unicorn Park, Woburn, MA 01801.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,747,547	Benson
7,036,730	Chung

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benson (US 6,747,547) in view of Chung (US 7,036,730).

Regarding claim 1, Benson teaches a wireless mobile device adapted to access a wireless network comprising a subscriber identification module (SIM) card slot and a smart card reader/writer module electrically connected to said wireless mobile device via said SIM card slot (Column 3, Lines 35-45; Column 5, Lines 64-67; Column 6, Lines 3-6; Benson) and wherein said smart card reader/writer module is adapted to receive and read information stored in a smart card and to transmit said information to an entity via said wireless network (Column 1, Lines 24-59; Benson), Benson teaches that through a novel smart card reader

writer module connected through an existing mobile device's SIM slot information can be wirelessly exchanged to another network entity (bank, network provider etc.) via said wireless network. However Benson fails to explicitly teach that the smart card resides outside of the mobile device and outside of the smart card reader without contacting said smart card. Chung teaches that contactless smart cards are an option in conjunction with smart card readers and writers that is contactless so that the smart card would reside outside of any device or reader, so that it does not contact that reader or device (Column 10, Lines 58-67, Column 11, Lines 1-6; Chung). Therefore it would be obvious to one of ordinary skill in the art to take the teaching of Benson and attempt to implement the contact smart card reader with that of a contactless smart card reader as taught by Chung as the outcome would be predictable and well known in the art and furthermore would be motivated by a desire to lessen actions required by an end user of physically inserting a smart card into a reader.

Regarding claim 2, Benson and Chung teach claim 1 wherein said smart card reader writer module is further adapted to receive information from said entity via said network and transmit and write said information in said contactless smart card (Column 10, Lines 58-67, Column 11, Lines 1-6; Chung).

Regarding claim 3, Benson and Chung teach claim 1 wherein said information is selected from a group consisting of cardholder identification information, card identification information, authentication information, smart card

issuer information, financial institution information, digital goods, digital services and digital currency (Column 1, Lines 39-49; Column 4, Lines 57-60; Benson).

Regarding claim 4, Benson and Chung teach claim 3, wherein said digital goods are selected from a group consisting of electronic cash, electronic coupons, electronic gift certificates electronic transit tokens, music, software, movies and books (Column 1, Lines 39-49; Column 4, Lines 57-60; Benson). The examiner takes official notice that use of electronic media is painfully well known in the art.

Regarding claim 5, Benson and Chung teach claim 1 further comprising a memory (Figure 4, Item 16; Benson) a CPU (Figure 4, Item 10; Benson) a SIM card connected to said SIM card slot (Figure 4, Item 19; Benson) said SIM card authenticating said wireless mobile device to said wireless network (Column 1, Lines 50-53; Benson) and a first application program (Figure 4, Item 11; Column 6, Lines 3-6; Benson) associated with said memory and said CPU and being adapted to receive and transmit instructions from said smart card reader/writer module to said wireless mobile phone and the reverse (Column 2, Lines 56-61; Column 6, Lines 1-19; Benson).

Regarding claim 6, Benson and Chung teach claim 5 further comprising a second application program associated with said memory and said CPU and being adapted to route and transmit data and information among said wireless mobile phone, said smart card reader/writer module, and other interfaces connected to said CPU (Figure 4, Item 14; Column 6, Lines 7-10; Benson).

Regarding claim 7, Benson and Chung teach claim 6, wherein said other interfaces are selected from a group consisting of smart card interfaces, infrared transceiver interfaces, serial communication interfaces, and magnetic stripe reader interfaces (Column 3, Lines 39-41; Benson).

Regarding claim 8, Benson and Chung teach claim 6, wherein said first and second application programs are stored in storage selected from a group consisting of said CPU, said SIM card, an external SIM card, said smart card and an external card (Column 1, Lines 1-38; Benson).

Regarding claim 9, Benson and Chung teach claim 1 wherein said smart card reader writer module further comprises an antenna for receiving and transmitting messages to and from said smart card without contacting said smart card (Column 10, Lines 58-67, Column 11, Lines 1-6; Chung).

Regarding claim 10, Benson and Chung teach claim 1, wherein said wireless mobile device is selected from a group consisting of a mobile phone a personal digital assistant, a pager, a wireless laptop computer, a personal computer a television remote control and combinations thereof (Column 1, Lines 9-12; Benson). Benson relates to communications apparatuses which obvious to one of ordinary skill in the art could be defined as a mobile phone a personal digital assistant, a pager, a wireless laptop computer, a personal computer a television remote control and combinations thereof.

Regarding claim 11, Benson and Chung teach claim 1, wherein said wireless network is selected from a group consisting of a WWAN, WLAN, private

network or PAN. Benson discloses a wireless link which obvious to one of ordinary skill in the art could be based on network platform with expected predictable results, therefore as Benson teaches networks it would be obvious to try any of a WWAN, WLAN, private network or PAN as an acceptable network.

Regarding claim 12, Benson and Chung teach claim 11, wherein said WWAN is selected from a group consisting of GSM, CDMA, CDMA 2000 and WCDMA. Consistent with the above logic if a WWAN were to be implemented the protocol of networking in said network would be obvious to one of ordinary skill in the art as they would all provide a predictable outcome and are widely utilized in the art for expected results.

Regarding claim 13, Benson and Chung teach claim 1, wherein said wireless mobile device is used for making financial transactions between a user and said entity and paying for said financial transactions with said smart card over said network (Column 1, Lines 39-49; Benson). Benson discloses bank transactions; therefore any well known obvious transaction could be handled by Benson, as the result is predictable and well known.

Regarding claim 14, Benson and Chung teach claim 13, wherein said financial transactions between said user and said entity are face to face (Column 1, Lines 39-49; Benson). Benson discloses bank transactions; therefore any well known obvious transaction could be handled by Benson, as the result is predictable and well known.

Regarding claim 15, Benson and Chung teach claim 13, wherein said financial transactions between said user and said entity are remote (Column 1, Lines 39-49; Benson). Benson discloses bank transactions; therefore any well known obvious transaction could be handled by Benson, as the result is predictable and well known.

(10) Response to Argument

1. The Benson reference was not relied on by the Examiner to teach a contactless card reader. The Benson reference was used to teach connecting a card reader to a wireless mobile phone through the phone's subscriber identification module (SIM) slot (see column 6, lines 3-6 Benson). Benson essentially provides that a card reader, not necessarily of a wireless (or "contactless") type, may be electrically connected through a mobile phone's existing SIM slot. Therefore the Examiner looked to a teaching in Chung stating that "If reader/writer RW is a wireless or contact-less-type reader for use with wireless or contact-less-type smart cards..." (see column 10, lines 60-62 of Chung). The recitation explicitly teaches the existence of contactless card readers as a known device, which has the same purpose, in wireless and wired implementation. The contactless card readers also have the widely recognized property in the telecommunications art of being more convenient to an end user in that the end user would not have to physically insert any media into the card reader. The end user would be able to merely hold the two items (smart card and reader) in a reasonably close range to achieve the same function (normally transfer of data between the smart card and reader) as that of contact reader.

2. The Examiner has merely looked to Chung to teach a design choice of either a contact or contactless smart card reader (see Chung at column 10, lines 60-62). The Examiner has not tried to bodily incorporate the entire scope of the Chung reference into the Benson art. Assuming *arguendo* that a voting machine may not be analogous to a wireless mobile device that does not bar the inherent benefits of a contactless card reader/writer from being used in either of these devices. The mere fact that a teaching of a design choice between contact or contactless reader/writer originated from a voting machine does not preclude that teaching, under 35 U.S.C. § 103(a), from being used in any other device.

3. In stark contrast to the Appellant's arguments, the Benson reference taken alone does exactly as the Appellant's claim is recited. Benson teaches connecting a smart card reader/writer to a wireless phone's SIM slot so as to transfer data to and from the smart card to a remote entity (see column 1, lines 39-49; discussing the need for other entities to authenticate data via a phone)(see also column 2, lines 32-50; describing in admittedly obtuse verbiage, the authentication of data in a smart card to be interface wirelessly through the phone to an external network entity [e.g. a bank or police]). The Chung reference was merely imported, in an anything but random fashion, to show that the ease of a designer to select a contact or contactless was known in the art.

4. The reverse is not actually claimed and therefore should be irrelevant. Claim 1 merely requires a showing of transmitting information from a smart card (read via a contactless smart card reader/writer) to an entity via said wireless network. Benson

teaches just this by stating that authentication data of use to either a bank or police personnel may receive information from an end user with a smart card in conjunction and Benson's disclosed invention (see column 1, lines 39-49; column 2, lines 32-50 of Benson).

5. Again as the Examiner has merely turned to Chung for a teaching of a designer's choice between either a contactless or contact card reader/writer, any implications of a voting system are wholly irrelevant, as the Examiner has not looked to any of those teachings to supplement the rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/C. A. H./

Examiner, Art Unit 2618

July 10, 2009

Conferees:

/Edward Urban/

Supervisory Patent Examiner, Art Unit 2618

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